

## **Remarks**

### **I. Response to Restriction Requirement**

This is responsive to the restriction requirement mailed August 6, 2002. Applicant has cancelled some of the claims, namely claims 68-76, in the elected group. In addition, applicant has added claims by the above amendment for the purpose of provoking an interference, as described below. Applicant believes that the remaining elected claims, claims 62-67 and 77-87, and the newly added claims 88-98, are all drawn to the same invention because they all relate to bonus jackpots and pool segregation. If, however, the Examiner believes that the claims as amended above are drawn to different inventions, applicant requests that the Examiner call the undersigned to see if this could be resolved in a telephone conference.

### **II. Request for Declaration of Interference**

Applicant requests that the Office declare an interference between the present application and US Patent No. 5,885,158, issued March 23, 1999 to Torango *et al.* (the '158 patent).

#### **A. Proposed Count**

In accordance with 37 CFR §1.607(a)(2), applicant proposes the following count:

1. A method for providing a progressive gaming system implemented using central computer coupled, at least indirectly, to gaming terminals each of which is coupled to a notification device for indicating the win of a progressive prize, the method comprising:

receiving, in said central computer, first information indicating contributions towards a first progressive prize from a first plurality of said gaming terminals eligible for said progressive prize;

receiving, in said central computer, second information indicating contributions towards a second progressive prize from a second plurality of said gaming terminals eligible for said second progressive prize;

transmitting from said central computer, when said first progressive prize has been won, information for activating at least one notification device coupled to one of said first plurality of gaming terminals; and

transmitting from said central computer, when said second progressive prize has been won, information for activating at least one notification device coupled to one of said second plurality of gaming terminals.

### **B. Claims Corresponding to the Proposed Count**

In accordance with 37 CFR §1.607(a)(3) and (4), applicant identifies the following claims corresponding to the proposed count: at least claim 16 of the '158 patent and at least claim 93 of the present application. These claims each correspond exactly to Count 1.

The claim chart attached as Appendix I applies the terms of claim 93 above to the disclosure of this application as required by 37 CFR §1.607(a)(5). The notation *App. \_\_\_\_*, as used in Appendix I, refers to the present application followed by a page and line number. Claim 93 is supported as indicated in Appendix I, among other places.

### **C. The Requirements of 35 USC §135(b) are Met**

Even though the claim that corresponds to the proposed count was not present in the application until more than one year after the issue date of the '158 patent, the requirements of 35 USC §135(b) are met. These requirements are paraphrased in the MPEP:

If the claim presented or identified as corresponding to the proposed count was added to the application by an amendment filed more than one year after issuance of the patent . . . then under the provisions of 35 U.S.C. 135(b), an interference will not be declared unless at least one of the claims which were in the application, or in a parent application, prior to expiration of the one-year period was for "substantially the same subject matter" as at least one of the claims of the patent. MPEP §2307.

Here, claims 62-68 in the attached Appendix II, among others, were presented in an amendment filed in the grandparent application, Application No. 08/465,717, filed June 6, 1995, from which the present application claims priority. These claims were filed with a certificate of mailing dated March 13, 1996, which is long before the '158 patent issued. The grandparent application issued as US Patent No. 5,836,817 on November 17, 1998. As a result, the claims upon which applicant relies as being for "substantially the same subject matter" as at least one of the '158 patent claims were no longer pending when the '158 patent issued.

This, however, does not prevent applicant from using the claims in Appendix II to satisfy the §135(b) requirements. The Court of Customs and Patent Appeals has specifically approved relying on claims that were no longer pending to meet these requirements in *Cryns v. Musher*, 73 USPQ 290 (1947) (claims cancelled after the interfering patent issued) and in *Corbett v. Chisholm and Schrenk*, 196 USPQ 337 (1977) (claims cancelled before the interfering patent issued). In *Corbett*, the Court followed the reasoning of *Cryns*:

We see no language in §135(b) . . . which requires the *Cryns* reasoning to be restricted to the cancellation of claims *after* the patent issued.

We conclude that the claims to be considered in this appeal are claims 24-27, even though cancelled prior to issuance of Chisholm's patent . . . *Id. at 342.*

As a result, the claims in Appendix II can be reviewed to determine whether they meet the §135(b) requirement by claiming "substantially the same subject matter" as at least one of the claims of the patent. To meet this requirement, all material limitations of the patent claim must be included. MPEP §2307. These material limitations—and how they compare to claim 16 of the '158 patent, which corresponds exactly to the count—are addressed next.

Claim 66 is directed to tracking a percentage of money played in each of two groups. This tracked money is allocated to corresponding pools or "prizes," as referred to in claim 16. A predetermined event that results in the issuance of a network command causing the pool to be paid by one of the gaming device corresponds, of course, to a win. This limitation (i.e., the last subparagraph of claim 62) therefore includes all of the material limitations corresponding to the claim 16 limitation: "transmitting from said central computer, when said first progressive prize has been won, information for activating at least one notification device coupled to one of said first plurality of gaming terminals..." One type of notification covered by applicant's claim is payment to a credit meter on the game, which notifies the player when it advances. And what could be more definite notification—also covered by applicant's claim—than paying by coins from the hopper or by a hand pay?

It should be noted that the term *progressive* as used in the '158 patent, simply refers to a pool that accrues from game-to-game, as opposed to a pool that accrues from game-to-game *and* is paid based on result of play of one of the gaming machines. This can be seen, e.g., in claim 7 of the '158 patent, where the decision as to whether the first progressive prize has been won is independent of the result of play in any of the games.

Considering applicant's claims, the word *progressive* is added as a limitation in claims 63 and 66. But it can be seen that claim 65, e.g., covers accruing money from a plurality of gaming devices in two groups until the occurrence of a predetermined event. This event might be related to gaming device play, such as a winning result, or not, such as a random award. But as seen in claim 7 of the '158 patent, the claimed "progressive prize," is the same as applicant's "pool" because both can be tied to gaming-device results, or not. In other words this limitation is inherent. "[A] material limitation need not be expressed explicitly, but may also be expressed inherently if the material limitation 'necessarily results' from other limitations in the claim." *In re Berger*, 61 USPQ2d 1523, 1528 (Fed. Cir. 2002).

But the inquiry is not closed even if the Examiner should decide that the *progressive* limitation is not inherent. In deciding whether the 135(b) requirements are met, the Examiner can properly consider that claims 63 and 66 each expressly claim a "progressive jackpot" for each pool even though these limitations appear in two claims. In *Thompson v. Hamilton*, 68 USPQ 161 (CCPA 1946), the court rejected the notion that the applicant "may not make [the count] because he did not present, within one year after [the patent issued], in just one claim, a claim embracing all the features which rendered the count patentable." *Id.* at 163.

In declining to find that the same or substantially the same subject matter must be embraced in a single claim, the Court adopted with approval the reasoning of the Board of Interference Examiners: "[A]ll that is required is that he shall be urging claims covering the matter which is claimed in the patent before the critical period has terminated." *Id.* at 164.

Finally, even if the Examiner should decide that this limitation is not inherent and that the combined limitations in claims 63 and 66 cannot be relied on, applicant directs the Examiner's attention to claim 80 in the grandparent application, Application No. 08/465,717, filed June 6, 1995, from which the present application claims priority. Claim 80 was presented in an amendment filed on February 12, 1997. This amendment adds the limitation that the first bonus is a progressive jackpot, and depends ultimately from claim 66, which limits the second bonus to a progressive jackpot. While claims 62, 65, and 66 in the February 12, 1997 amendment have more limitations than the claims in Appendix II, the limitations as originally presented (in Appendix II) remain. As a result, claim 80 could also be relied upon to satisfy the §135(b) requirements.

#### **D. Copied Claims**

As required by 37 CFR §1.607(b), applicant identifies the following claims that are copied from the '158 patent and added by the above amendment in the same sequence: 1, 2, 3, 4, 5, 16, 17, 18, 22, 24, and 30.

#### **E. Statement Under 37 CFR §1.608(a)**

The undersigned attorney of record alleges, in accordance with 37 CFR §1.608(a), that there is a basis upon which the applicant in the above-captioned application is entitled to a judgment relative to the patentee of US Patent No. 5,885,158 in an interference between the two.

#### **III. Conclusion**

Please examine the application as amended. Please also review the Acres patents listed on the IDS submitted herewith for potential double patenting. Although four of those listed were considered in one or more of the applications from which this application claims priority, one is newly submitted. All are listed and copies included for the Examiner's convenience. Each of these patents has substantially the same specification as the present application.

The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,



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